



UNITED STATES PATENT AND TRADEMARK OFFICE

u
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,781	09/20/2005	Antonio Carlos Favero Caires	APA-PT005	8504
3624	7590	11/30/2006	EXAMINER	
VOLPE AND KOENIG, P.C. UNITED PLAZA, SUITE 1600 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103			LAO, MARIALOUISA	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/525,781

Applicant(s)

CAIRES ET AL.

Examiner

MLouisa Lao

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 93-184 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 93-184 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Art Unit: 1621

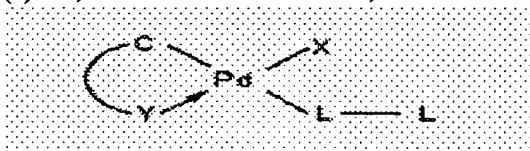
DETAILED ACTION***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

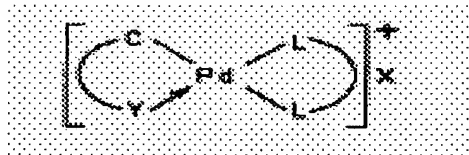
This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

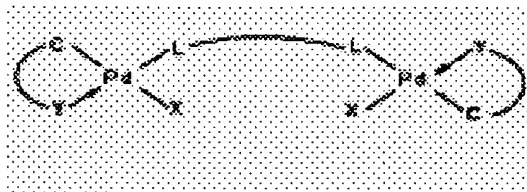
Group I, claim(s) 93, 172-173 and 175-184, drawn to the structure as shown below and its use.



Group II, claim(s) 94, drawn to the structure as shown below.



Group III, claim(s) 95, drawn to the structure as shown below.



Group IV, claim(s) 114-150 and 174, drawn to a composition comprising at least one compound of claim 93 or one of its pharmaceutically acceptable salts or adducts.

Group V, claim(s) 151-171, drawn to a method to inhibit the activity of proteins linked to disorders or diseases.

Art Unit: 1621

The inventions listed as Groups I - V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I, II and III are drawn to dissimilar structures, where Group I is mononuclear, Group II is mononuclear with a cyclic biligand, Group III is binuclear, which invariably are expected to exhibit different attributes. Group IV is drawn to a composition, where the excipients play roles to the compound of the structure as recited; whereas, Group V is a method to inhibit the activity of proteins linked to disorders or diseases using said composition.

2. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

A. The species of a cyclopalladated **“compound”** of claim 93, the claims are as recited so as not to obfuscate the scope and intent of the applicants, are as follows:

- a. the plurality of derivatives in claim 96
- b. the plurality of diseases in claim 106

B. The species of a **“composition”** of a compound of claim 93 are as recited so as not to obfuscate the scope and intent of the applicants, are as follows:

- a. the plurality of dosage forms, either solid or liquid in claim 120
- b. the plurality of modes of administration in claim 122
- c. the plurality of diseases in claim 135

C. The species of a **“dosage unit”** of a compound of claim 93 are as recited so as not to obfuscate the scope and intent of the applicants, are as follows:

Art Unit: 1621

a. the plurality of dosage forms in claim 148

D. The species of a “**method**” are as recited in the claims so as not to obfuscate the scope and intent of the applicants, are as follows:

a. the plurality of diseases in claims 161-162

E. The species of a “**use of**” are as recited in the claims so as not to obfuscate the scope and intent of the applicants, are as follows:

a. the plurality of diseases in claim 177

Applicant is respectfully required, in reply to this action, to elect a single disclosed species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election. The examiner reserves the right to further restrict the elected species, when an election is so made.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional disclosed species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Art Unit: 1621

3. The claims deemed to correspond to the species listed above are as recited in the aforementioned paragraphs in the manner stated.

4. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: for A – these are directed to different structures emanating from different substituents; for B- these are compositions with varying dosage units and modes of administration; for C- these recite, but duplicate, the statements for various dosage forms and modes of administration; for D- these recite methods of a myriad of uses; for E- these duplicate the recitation of uses.

5. A telephone call was not made to the applicants' agent to request an oral election to the above restriction requirement, due to the complexity in the arts. MPEP §812.01.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Art Unit: 1621

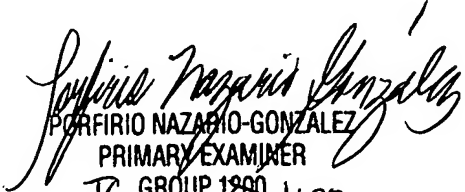
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MLouisa Lao whose telephone number is 571-272-9930. The examiner can normally be reached on 8:30am to 5:30pm Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ml1112006


PORFIRIO NAZARIO-GONZALEZ
PRIMARY EXAMINER
TC GROUP 1200 1/600